

REMARKS

Claims 7-9 and 11-14 are pending in this application. Claims 7-9 stand rejected. The Examiner failed to address Claim 11 but rejected Claim 10 – a claim previously cancelled. Claims 12-14 are new. Claims 12-14 closely reflect Claims 1-3 (now cancelled) of the application as originally filed and, thus, do not claim new matter.

THE SPECIFICATION: The Examiner objected to the specification as failing to disclose limitation found in Claims 8 and 11. Claims 8 and 11 have been amended to address the Examiner's concerns.

CLAIM REJECTIONS – 35 USC § 103: The Examiner rejected Claims 8 and 9 as being anticipated by USPN 5,889,578 issued to Jamzedah in view of USPN 4,582,200 issued to Hicks.

Jamzedah discloses an apparatus for making prints from a roll of photographic film negative strip. The apparatus includes a film scanner capable of scanning frames of a photographic roll of film of a fixed format to generate digital images of the roll's contents. Jamzedah, col. 3, lines 50-62. Hicks discloses a film based camera having an associated input device and memory. Hicks, Fig. 1A. Processing instructions for images taken using the camera are entered through the input device and saved in the memory. Hicks, col. 6, lines 10-60. The processing instructions for a particular image are stored in a memory location that is in some manner associated with that image.
Hicks, Col. 7, lines 7-15

In contrast, claim 8 is directed to an apparatus and requires the following limitations:

1. a scan module;
2. a print module;
3. an input device for allowing at least a first photo size, a second photo size, and a Photo Package entry to be selected; and
4. a controller for causing the scan module to scan the image, the controller

- automatically determining actual size of the scanned image, generating first scanned image copies that are scaled to the first photo size and that are positioned to utilize maximum printable area on the sheet, and causing the print module to print the first copies on the sheet, and
5. wherein the controller is configured to, when the Photo Package entry is selected, generate second scanned image copies that are scaled to the second photo size and cause the print module to print the second copies on an additional sheet.

The Examiner mistakenly contends that Jamzedah teaches a controller that is capable of automatically determining actual size of the scanned image as required by the fourth limitation. To this end, the Examiner cites Jamzedah, col. 7, lines 33-36 and 55-63 and col. 8, lines 8-16. Jamzedah, col. 7, lines 33-36 provides that, for enlargement prints, a negative frame will be scanned at a specified full resolution. Jamzedah, col. 7, lines 55-63 discloses that different sized prints can be arranged on a single sheet. Jamzedah, col. 8, lines 8-16 discloses a method for computing an interpolation ratio for resizing a digital image.

Jamzedah teaches scanning a frame of a negative strip of a fixed format at a desired resolution. The negative frame scanned is always the same size – so there would never be a need to identify an actual size of a scanned image. Consequently, Jamzedah does not teach or suggest a controller capable of identifying the actual size of a scanned image and then generating copies of the scanned image that are scaled to a particular size as required by the fourth limitation above.

The Examiner mistakenly contends that Hicks teaches the fifth limitation above. Specifically, the Examiner cites Hicks, col. 6, lines 20-25, 44-50, and 57-60, col. 10, lines 15-20, and col. 11, lines 25-28 and 35-43. Hicks, col. 6, lines 20-25 discloses that a package selection is a mixture of various photo sizes of a particular subject. Hicks, col. 6, lines 44-50 discloses that a user can press a code button for a particular package selection for a particular subject to ensure that the subject will receive, at the time the order is processed, photo prints indicate by the package selection. Hicks, col. 6, lines

6, lines 57-60 discloses that the camera's shutter acts as a trigger to expose film and simultaneously transmit electronic data regarding the particular order (the package selection) to a memory module. Hicks, col. 10, lines 15-20 discloses that a photographic processing sequence once written to memory serves as a source for functions in a commercial photo finishing process. Hicks, col. 11, lines 25-28 discloses a photographic printer that exposes each negative on a roll according to instructions contained in the memory. Hicks, col. 11, lines 35-43 discloses that an exposed roll of prints is mounted to a print cutter that is guided by a microcontroller. Cutting instructions are obtained from the memory.

Hicks makes no mention of a controller capable of generating second scanned image copies that are scaled to a second photo size when a Photo Package entry is selected and then causing a print module to print the second copies on an additional sheet as required by the fifth limitation above. Hicks does not even disclose generating a scanned copy of an original image. Instead, Hicks discusses dark room methods for producing photo prints from negatives. Hicks, col. 10, line 16 through col. 11, line 13.

For at least these reasons, Claim 8 is felt to distinguish over Jamzedah and Hicks. Claim 9, depends form Claim 8 and includes all the limitations of that base claim. For the same reasons Claim 8 is patentable, so is Claim 9.

The Examiner rejected Claim 7 as being anticipated by Jamzedah in view of Hicks and in further view of USPN 6,183,933 issued to Ishikawa. Claim 7, depends form Claim 8 and includes all the limitations of that base claim. For the same reasons Claim 8 is patentable, so is Claim 7

The Examiner rejected Claim 10 as being anticipated by Jamzedah in view of Hicks, in further view of USPN 4,847,662 issued to Yamada and in further view of USPN 6,236,473 issued to Collard. Claim 10 was cancelled in a response filed July 31, 2003.

While Claim 11 is listed as rejected in the Office Action Summary, the Examiner neglected to address Claim 11 in the Detailed Action. Claim 11 is directed to an article of manufacture for an apparatus that includes a scan module, a print module, an input device, a display device, and a processor. Claim 11 requires the following limitations:

1. computer memory; and
2. a program stored in the computer memory, the program, when executed, commanding the processor to display a Photo Features entry on the display device; the program commanding the processor to command the scan module to perform a pre-scan when the Photo Features entry is selected via the input device;
3. the program further commanding the processor to automatically determine actual size of an output of the scan module after the pre-scan is performed; command the scan module to perform a full scan; generate first scaled copies of an output of the scan module after the full scan is performed, the first copies being scaled to a first size indicated by the selected entry;
4. the program further commanding the processor to rotate the copies if necessary to utilize maximum printable area on the sheet; and cause the print module to print the first copies on the sheet,
5. wherein the program commands the processor to display a Photo Package entry on the display device, and wherein the controller generates second scaled copies of the output of the scan module, the second copies being scaled to a second size indicated by the selected entry and the controller causes the print module to print the second copies on an additional sheet when the Photo Package entry is selected via the input device.

As noted above, the art cited by the Examiner (Jamzedah) does not teach or suggest a program capable of identifying the actual size of a scanned image and then

generating copies of the scanned image that are scaled to a particular size as required by the third limitation above. Moreover, the art cited by the Examiner (Hicks) makes no mention of a program capable of generating second scanned image copies that are scaled to a second photo size when a Photo Package entry is selected and then causing a print module to print the second copies on an additional sheet as required by the fifth limitation above.

For at least these reasons, Claim 11 is felt to be patentable over the art cited by the Examiner.

Claim 12 is directed to an apparatus for scanning and printing copies of an original image and requires the following limitations:

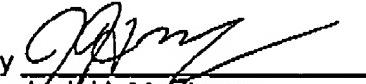
1. a scan module operable to scan the original image;
2. a print module operable to print copies of the original image;
3. an input device operable to allow one or more photo sizes to be selected; and
4. means for causing the scan module to scan the original image, the means automatically determining an actual size of the scanned image and scaling copies of the scanned image to a photo size selected via the input device, the means also causing the print module to print the copies on a sheet.

As noted above, the art cited by the Examiner (Jamzedah) does not teach or suggest a means capable of identifying the actual size of a scanned image and then generating copies of the scanned image that are scaled to a particular size as required by the fourth limitation above. For at least this reason, Claim 12 is felt to be patentable. Claim 13 and 14 depend from Claim 12 and each include all the limitations of that base claim. For the same reasons Claim 12 is patentable, so are Claims 13 and 14.

CONCLUSION: The foregoing is believed to be a complete response to the outstanding Office Action. Claims 7-9 and 11-14 are felt to be in condition for allowance. Consequently, early and favorable action allowing these claims and passing the application to issue is earnestly solicited. The foregoing is believed to be a complete response to the outstanding Office Action.

Respectfully submitted,

Gregory T. Hulan

By 

Jack H. McKinney
Reg. No. 45,685

June 1, 2004